



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,712	11/08/2005	Marc Eloit	270423US0XPCT	9314
22850 7590 12/06/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER BURKHART, MICHAEL D				
ART UNIT		PAPER NUMBER		
1633				
NOTIFICATION DATE		DELIVERY MODE		
12/06/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/530,712

Applicant(s)

ELOIT ET AL.

Examiner

Michael Burkhart

Art Unit

1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 23 and 24.
Claim(s) rejected: 22, 26-28, 31, 52, 54, 55 and 61-63.
Claim(s) withdrawn from consideration: 25, 30, 37-51 and 56-60.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Michael Burkhart/
Primary Examiner, Art Unit 1633

Continuation of 3. NOTE: Claim 22 (from which all other claims under examination depend) has been amended to recite that the claimed adenovirus retains "all of the E1A coding sequence as well as regions of the E1 gene located downstream thereof, said regions including the E1A polyadenylation signal and the E1B region." Such a limitation was not recited in any previously pending or examined claim. Thus, the amended claims require further consideration of the application as filed for support of the amendment, along with consideration and search of the prior art for teachings of such a limitation.

Continuation of 11, does NOT place the application in condition for allowance because:

Claims 52, 54 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is maintained for reasons made of record in the Office Action dated 11/16/2009, 6/11/2010, and for reasons set forth below.

Claims 52 and 54 recite the limitation "the original replicating adenovirus" in line 6 of claim 52, and in lines 2-3 of claim 54. There is insufficient antecedent basis for this limitation in the claims. This rejection affects all dependent claims.

Response to Arguments

Applicant's arguments filed 11/11/2010 have been fully considered but they are not persuasive. Applicants essentially assert that the claims have been amended such that the rejection is moot. Because the amendment of the claims has not been entered, this is not the case.

Claims 22, 26-28, 31, 52, 54 and 55 are rejected under 35 U.S.C. 102(b) as being taught by Soudais et al (2001, of record). This rejection is maintained for reasons made of record in the Office Action dated 11/16/2009, 6/11/2010, and for reasons set forth below.

Response to Arguments

Applicant's arguments filed 11/11/2010 have been fully considered but they are not persuasive. Applicants essentially assert that: 1) Soudais et al do not teach the claimed virus which must replicate and produce infectious particles, primarily because the viruses of Soudais et al do not comprise the E1 region; 2) the vectors of the amended claims have a deletion which ends before the beginning of the E1A coding region, and are thus distinguished from those taught by Soudais et al by comprising the E1 region.

Regarding 1), such is not convincing for reasons of record. The viruses of Soudais et al replicated and produced infectious particles in certain cell lines despite applicants protests to the contrary, see page 3 of the previous Office Action.

Regarding 2), this reading of the claims requires that the claim amendments be entered. They have not, hence, this argument is moot. That the adenovirus vectors of Soudais et al lack the E1 region is stipulated; however, this feature does not distinguish the vectors of Soudais et al and the instant claims, which do not recite that they comprise the E1 region.

Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soudais et al (2001, of record) in view of Haddada et al (U.S. patent 6,294,377, 2001). This rejection is maintained for reasons made of record in the Office Action dated 11/16/2009, 6/11/2010, and for reasons set forth below.

Response to Arguments

Applicant's arguments filed 11/11/2010 have been fully considered but they are not persuasive. Applicants essentially assert that: 1) Haddada et al does not make up for the deficiencies of Soudais et al as set forth above; 2) the claimed vectors, as amended, retain the E1 region, whereas the vectors of Soudais and Haddada et al do not.

Regarding both 1) and 2), Soudais et al is not considered to have any deficiencies regarding claim 22 for the reasons set forth above. Again, the vectors of both Soudais and Haddada et al are replicative in complementing, E1-expressing cell lines. Furthermore, applicants arguments toward the amended claims, i.e. that the instantly claimed adenoviruses comprise the E1 region, are moot as the amendment has not been entered.